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EXAMINER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12

Application Number: 08/910,980
Filing Date: August 7, 1997
Appellant(s): Thomas D. Petite

Daniel R. McClure
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed November 15, 1999.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2) ***Related Appeals and Interferences***

1 A statement identifying the related appeals and interferences which will directly affect
2 or be directly affected by or have a bearing on the decision in the pending appeal is contained
3 in the brief. However, the statement describing the continuity of this application is incorrect
4 and should read as follows: The present application is a CIP of U.S. patent application serial
5 numbers 08/825,576 filed March 31, 1997, and **08/895,720** (now U.S. Patent No. **5,926,531**),
6 filed July 17, 1997. Application serial number 08/825,576 is presently under appeal.

7

8 (3) *Status of Claims*

9 The statement of the status of the claims contained in the brief is correct.

10

11 (4) *Status of Amendments After Final*

12 The appellant's statement of the status of amendments after final rejection contained in
13 the brief is correct.

14

15 (5) *Summary of Invention*

16 The summary of invention contained in the brief is correct.

17

1 **(6) *Issues***

2 The appellant's statement of the issues in the brief is correct.

3

4 **(7) *Grouping of Claims***

5 Appellant's brief includes a statement that claims that Group I, which comprises
6 claims 1-8; Group II which comprises claims 9-11 and 15; Group III, which comprises
7 claims 12 and 13; Group IV, which comprises claim 14 and Group V, which comprises claim
8 16 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and
9 (c)(8).

10 The examiner disagrees with appellant's statement in the brief that certain claims do not
11 stand or fall together. Since, Claim Group I, Claim Group III and Claim Group IV, claim the
12 same equivalent element "receiver or receiving means", there is insufficient distinction
13 between them, therefore, claims in said groups stand or fall together.

14

15 **(8) *ClaimsAppealed***

16 The copy of the appealed claims contained in the Appendix to the brief is correct.

1 **(9) Prior Art of Record**

2 The following is a listing of the prior art of record relied upon in the rejection of claims
3 under appeal.

4 5221838

Gutman et al.

06/22/93

5 **(10) Grounds of Rejection**

6 The following ground(s) of rejection are applicable to the appealed claims:

7 Claims 1-8, 12-15 drawn to the system and claims 9-11 drawn to the method are
8 rejected under 35 U.S.C. 103 (a). This rejection is set forth in prior Office action, Paper
9 No. 7.

10 Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite. This
11 rejection is set forth in prior Office action, Paper No. 7.

12 **(11) Response to Argument**

13 Claim Group I (Claims 1-8)

14 Appellant contends that Gutman fails to disclose the presence of "receiving means associated
15 with the communication device for receiving data transmitted via an electromagnetic waves."

16 Appellant also contends that since the "receiving means" is a means plus function element, it
17 must be construed in accordance with 35 U.S.C. § 112, sixth paragraph, and thus should be
18 construed in accordance with the structure set forth in the specification. The specification

1 defines the "receiving means" as an RF receiver (reference numeral 50 of Fig. 2). Therefore,
2 in order to meet such claimed limitation it is necessary to show that the receiving elements
3 disclosed by Gutman constitutes an RF receiver. The office action states that the financial
4 institution (512) constitutes said "receiving means," because of its capability of receiving data
5 transmitted by a remote access device. As part of the financial institution disclosed by
6 Gutman, there are several other components, such as a paging system (300), telephone
7 company equipment (308) and a financial institution computer system (306). Gutman further
8 discloses that the remote access device has the capability of transmitting information using
9 conventional techniques such as RF communication, IR communication and microwave
10 communication (column 8, lines 43-47). Because of the transmitter's capability of sending
11 information in an RF, IR or microwave format, it is inherent that the financial institution have
12 the appropriate "receiving means." Therefore, the claimed limitation of a receiving means of
13 the RF type, is clearly met by the disclosed financial institution disclosed by Gutman.

14 Appellant also contends that the "means for receiving" disclosed by Gutman, must have
15 a substantially similar function to applicants: namely "receiving user identification information
16 for forwarding to a financial institution." Gutman discloses that the remote access device can
17 send messages to the receiver, so as to carry out a variety of transactions. Since the
18 transactions carried out relate to a specific user, it is inherent that some form of user
19 identification data be forward to the "receiving means," thus meeting the claimed limitation.

Finally appellant contends that the "receiving means" is configured to receive data transmitted via electromagnetic waves and that Gutman fails to teach such. Gutman states that the communication of information can be carried out by a variety of techniques that include RF, IR and microwave format. As stated in the office action, paragraph five, all of such communication techniques make use of electromagnetic waves, thus, meeting the claimed limitation rendering applicants arguments moot.

Appellant contends that the electronic wallet disclosed by Gutman is analogous to the communication device of the claimed invention, and therefore, Gutman fails to teach the remote access unit. Such argument is traversed. The electronic wallet disclosed by Gutman constitutes the remote access unit, not the communication device. The communication device is the disclosed paging system (column 9, lines 45-51). Therefore, Gutman teaches the communication of financial information to a communication device (300) connected to a telecommunication network (308), which then relays information to a financial institution (306).

15

16 Claim Group II (Claims 9-11 and 15).

17 Appellant contends that Gutman fails to disclose the step of "transmitting a low-power
18 electromagnetic signal including the formatted user identification information." Although
19 Gutman fails to state the transmission of user identification information in such precise words,

1 however, such limitation would necessarily be present in view of the data being transmitted by
2 the electronic remote device disclosed by Gutman. Gutman recites that the electronic remote
3 device, stores financial information and balance information (column 7, lines 50-61). It is
4 notoriously well known in the art and old, that when information is transmitted from one
5 device to another, identification information is also transmitted. Therefore, such limitation is
6 inherent in Gutman's device.

7 Regarding the claimed limitation of transmitting a low-power electromagnetic signal,
8 such limitation is inherent in Gutman's device. Gutman as stated above has the capability of
9 transmitting wireless information in a variety of formats such as radio frequency, microwave,
10 optical and ultrasound. It is notoriously well known in the art that some of the disclosed
11 formats, are transmitted as a low-power electromagnetic signal. Therefore, the claimed
12 limitation disclosed by appellant is inherently taught by Gutman.

13 As for appellant's argument regarding the transmission of the extracted information
14 over the telephone line for authorization, such argument is not convincing in view of Gutman's
15 teaching (column 9, lines 10-43).

16

17 Claim Group III (Claims 12 and 13).

18 Appellant contends that Gutman fails to disclose "a communication device, a receiver
19 associated with the communication device and a remote access unit, further including a

transmitter adapted to transmit the user identification data to the receiver via electromagnetic waves."

However, as discussed above in claim group I, all such elements are taught by Gutman.

The financial institution (512) constitutes said communication device, furthermore, said communication device comprises a receiver (300). As for the claimed remote access unit, the electronic wallet disclosed by Gutman meets such claimed limitation.

Claim Group IV (Claim 14)

Appellant contends that Gutman fails to disclose "a communication device; receiving means; and a low-power transmitter adapted to transmit the user identification." All such claimed elements have been discussed in Claim Group I and it has been shown that Gutman meets such claimed limitations. Therefore, the same rejection applies to Claim Group IV.

Claim Group V (Claim 16)

Appellant contends that Gutman fails to teach the presence of a communication devise disposed for communication with a financial institution via a telecommunication link. However, such limitation has already been addressed in the discussion of Group I, wherein it has been shown that Gutman clearly teaches such recited elements.

Appellant also contends that Gutman fails to disclose a receiver disposed within the communication device. Such limitation has also been addressed above, and it has been stated that Gutman, does in fact teach the presence of receiving means or a receiver in the communication device. Therefore, appellant's arguments regarding such claimed limitation are not convincing in view of Gutman's teachings.

Finally appellant argues that Gutman fails to teach the transmission of a track one and a track two data in direct response to a manual depression of the user-depressible button, without any verification of user identification data. According to appellant's specification, "track one is defined data typically includes a person's name" and track two data "typically includes the person's account number and the encoded pin number." It is notoriously well known in the art that, whenever, financial data or authorization data is transmitted, information such as the one claimed is transmitted. Because Gutman, performs such exact same function, the transmission of data track one and data track two information is inherent.

1. An appeal conference was held in this application. The attendees were: Donald T. Hajec (Supervisory Patent Examiner), Michael E. Lee (Primary Examiner) and Douglas X. Rodriguez (Examiner).

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Applicant(s): Thomas D. Petite

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Art Unit: 2876

Representative: Daniel R. McClure

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Donald Hajec
Supervisory Patent Examiner
Technology Center 2800

8 D.X.R.

9 January 27, 2000

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